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APPLICATION NO. 657505,302	FILING DATE 12/12/97	FIRST NAMED INVENTOR GORNAN	ATTORNEY DOCKET NO. 051100
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HM11/1223

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EXAMINER TUNG, M
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ART UNIT 1234	PAPER NUMBER
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DATE MAILED: 12/23/98  
8

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**



UNITED STATES DEPARTMENT OF COMMERCE  
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DEA/FCE-1994

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/989,362	12/12/97	Gorman	DX0686

EXAMINER	
Mary Beth Tung	
ART UNIT	PAPER NUMBER
1644	

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application

Commissioner of Patents

All claims are allowable. However, due to a potential interference, *ex parte* prosecution is SUSPENDED FOR A PERIOD OF 6 MONTHS from the date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

*Mary B. Tung*  
December 22, 1998  
Mary B. Tung / Ph.D.  
Patent Examiner  
Group 1640

*Christina Chan*  
CHRISTINA Y. CHAN  
SUPERVISORY PATENT EXAMINER  
GROUP 1800-1640

# Notice of Allowability

Application No.

08/989,362

Applicant(s)

Gorman And Mattson

Examiner

Mary Tung

Group Art Unit

1644



All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

☐ This communication is responsive to \_\_\_\_\_.

☒ The allowed claim(s) is/are 1-6, 11-16, and 21-46.

☐ The drawings filed on \_\_\_\_\_ are acceptable.

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

☐ Applicant MUST submit NEW FORMAL DRAWINGS

☐ because the originally filed drawings were declared by applicant to be informal.

☐ including changes required by the Notice of Draftsperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. \_\_\_\_\_.

☐ including changes required by the proposed drawing correction filed on \_\_\_\_\_, which has been approved by the examiner.

☐ including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☐ Interview Summary, PTO-413

☐ Examiner's Amendment/Comment

☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

☒ Examiner's Statement of Reasons for Allowance

**DETAILED ACTION**

1. Claims 7-10, 17 and 18-20 were canceled in the pre-amendment filed December 20, 1998 (Paper No. 7).
2. Claims 1-6, 11-16 and 21-46 are pending.

**Election/Restriction**

3. Applicant's election with traverse of Group IV, claims 11-17 (now claims 11-16 and 28-46) in Paper No. 4 is acknowledged. The traversal is on the ground(s) that "the restriction requirement is improper because the claims are so closely related that they should remain in the same application to preserve unity of invention, and that examination of the groups together would not present a serious burden to the Examiner." This is not found persuasive because unity of invention is the criteria used in applications filed under 35 U.S.C. 371, and not in applications filed under 35 U.S.C. 111(a), as is the case with the instant application. Additionally, the applicants argue that Examiner has not addressed the issue of whether the search will be a burden, however, the subject matter, even though in the same classes, are classified in different subclasses, therefore, a search of one will not be co-extensive with the others. Therefore the restriction is proper.

4. Applicant has further elected in Paper No. 4, the species of a full-length coding nucleic acid sequence, and the embodiment of a human cell. Claims 11-17 (now claims 11-16 and 28-46) are readable on the elected species. Since the elected species is now found to be free of the prior art, the prior art search has been extended to cover all species.

5. Upon reconsideration, Group I, claims 1-6 (now claims 1-6 and 21-27), drawn to the polypeptide and composition has been rejoined with Group IV, claims 11-17, <sup>(now claims 11-16 and 28-46)</sup> drawn to a nucleic acid.

6. In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

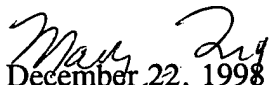
**REASONS FOR ALLOWANCE**

8. The following is an Examiner's statement of reasons for allowance: The claimed invention is drawn to a polypeptide of SEQ ID NO: 2 and a nucleic acid encoding said polypeptide, encompassed by SEQ ID NO: 1, said polypeptide being a putative member of the tumor necrosis factor ligand family. Gruss and Dower (AF) teach a tumor necrosis factor ligand (see the abstract, in particular), while Lacey, et al. (ANTIGEN) teach an osteoprotegrin ligand, a polynucleotide encoding said polypeptide, a vector and host cell (see the abstract and Figure 1, in particular), that is also a TNF-related polypeptide. Neither reference, however, teaches or suggests either the polynucleotide of SEQ ID NO: 1 or the polypeptide of SEQ ID NO: 2.

9. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. Papers related to this application may be submitted to Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). THE CM1 FAX CENTER TELEPHONE NUMBER IS (703) 305-3014 or (703) 308-4242.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mary Tung whose telephone number is (703)308-9344. The Examiner can normally be reached Monday through Friday from 8:30 am to 5:30 pm. A message may be left on the Examiner's voice mail service. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1640 receptionist whose telephone number is (703) 308-0196.

  
December 22, 1998  
Mary B. Tung, Ph.D.  
Patent Examiner  
Group 1640

  
CHRISTINA Y. CHAN  
SUPERVISORY PATENT EXAMINER  
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